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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,852	09/29/2003	Lea Antony Ashfield	014A.0020.U1(US)	6316

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EXAMINER

HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,852

Applicant(s)

ASHFIELD, LEA ANTONY

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-6, 10, 14-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Juratovac et al (D408,246), hereafter Juratovac. Juratovac discloses a battery operated chain saw with all of the elements described in the claim limitations. The figures clearly show a removable battery coupled to the motor in the figures. The battery and power pack is the oval shaped member shown in the figures. The electric motor lies within the vented motor housing shown in the figures adjacent to the oval-shaped battery. The center of gravity of Juratovac is located at least partially the front handle as shown in the figures. The battery receiving area is on the back of the motor housing juxtaposed the oval-shaped battery and the motor housing as shown in the figures. The front-to-rear centerline is collinear with the rear handle and the battery is entirely spaced from the front-to-rear centerline as shown in figure 3. Juratovac inherently has an electrical coupling on the battery/power pack because every battery/power pack needs an electrical coupling in order to supply its power to a motor. Note the elements of the present limitations labeled below in Diagram 1.

In regards to claim 20, the power pack is located at least partially in front of the front handle when the front-to-rear centerline is in an inclined or vertical position.

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In regards to claim 10, the configuration of the chain saw in Juratovac is the means that locates the front-to-rear chain saw center-of-gravity proximate the front handle.

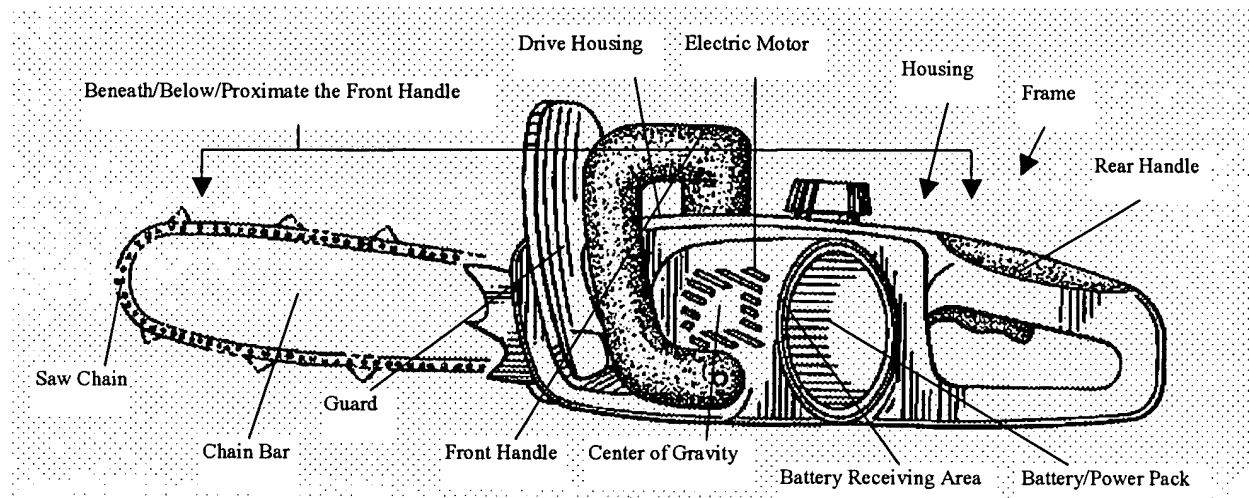


Diagram 1. Labeled elements of the present limitations.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Juratovac in view of Gassen et al (5,016,355), hereafter Gassen. Juratovac discloses everything as noted above, but does not disclose a housing made of molded polymer members. However, Gassen teaches a housing made of molded polymer members in column 2, lines 11-21. It would have been obvious to provide a housing made of molded polymer member in Juratovac as taught by Gassen in order to make the chain saw lighter in weight.

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5. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Juratovac in view of Anthony, III et al (5,213,913), hereafter Anthony. Juratovac discloses everything as noted above, but does not teach a mechanical latch. However, Anthony teaches mechanical latch 40. It would have been obvious to provide the power pack in Juratovac with a mechanical latch as taught by Anthony in order to further secure the power pack in place during cutting operations.

6. Regarding claims 7, 8, 17 and 18, Juratovac discloses all of the limitations as shown above, but does not disclose the orientation of the electrical coupling. It would have been obvious for Juratovac to locate the electrical coupling on a side other than a lateral side, and facing a forward direction in order to supply the power of the battery/power pack more directly to the motor in the motor housing juxtaposed to the battery. It has been held that shifting the location of parts is obvious to one of ordinary skill in the art if the operation of the device would not thereby be modified. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

Response to Arguments

Applicant's arguments filed 03/03/06 have been fully considered but they are not persuasive. Applicant asserts that Juratovac provides no description of where the center-of-gravity is located on the Juratovac saw, however, one of ordinary skill in the art knows that the center of gravity of chain saws of the type in Juratovac is located below the top part of the front handle in order to hold the chain saw in a level position with one hand of a user. The center of gravity being below the front handle is further evidenced by Inaga, Pilatowicz, Green et al and Strunk.

In regards to claim 20, applicant asserts that the power pack is not at least partially in front of the front handle, however, the power pack is at least partially in front of the front handle when the front-to-rear centerline of the frame is in an inclined or vertical position, such as when an operator is sawing over his head. Moreover, if applicant is implying that the power pack is at least partially in front of the front handle when the front-to-rear centerline of the frame is in a horizontal position in front of the operator, then the claim limitation would be deemed to be new matter due to the lack of support in the specification for such a limitation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, applicant asserts that there is no motivation for providing the latch of Anthony on the power pack of Juratovac without the improper use of hindsight; however, one of ordinary skill in the art recognizes the need for a latch in order to secure a battery to a power tool.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH
May 29, 2006



KENNETH E. PETERSON
PRIMARY EXAMINER